

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	Arthur Ernest Conrad, <i>et al.</i>
Application No. 09/903,976*	Filing Date: July 12, 2001
Title of Application:	Web Attract Loop
Confirmation No. 9444	Art Unit: 3622
Examiner	Namrata Boveja

Mail Stop Appeal Brief - Patents
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

Reply Brief Under 37 CFR §41.41

Dear Sir:

Having received the Examiner's Answer, Appellant submits this Reply Brief for the above-captioned application pursuant to 37 C.F.R. §41.41 as follows. Applicant believes that no fee is due in connection with this filing. However, if any additional fee is due, please charge Deposit Account No. 19-4516.

Status of Claims

Claims 1-44 stand rejected and are the subject of the instant Appeal.

Grounds of Rejection

Claims 1-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Claims 1, 2, 4, 6, 8-12, 14, 16, 18-24, 26, 28, 30-34, 36, 38 and 40-44 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. (U.S. Patent No. 6,084,583) in view of Cho et al. (U.S. Patent No. 6,834,048).

Claims 3, 5, 13, 15, 25, 27, 35 and 37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. in view of Cho et al. and further in view of Park et al. (U.S. Patent No. 6,295,061).

Claims 7, 17, 29 and 39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. in view of Cho et al. and further in view of the article titled "An Internet newcomer is making money by selling moving ads as part of screen savers" written by David Barboza for the New York Times on October 1, 1996 on page D.7 (hereinafter "Barboza").

Claims 1, 2, 4, 6, 8-12, 14, 16, 18-24, 26, 28, 30-34, 36, 38 and 40-44 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. in view of the article titled "Tiny pager gives big picture; Innovation," written by Max Glaskin in The Times on September 24, 1995 on page 1 (hereinafter "Glaskin").

Claims 3, 5, 13, 15, 25, 27, 35 and 37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. in view of Glaskin and further in view of Park et al.

Claims 7, 17, 29 and 39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. in view of Glaskin and further in view of Barboza.

Reply to Examiner's Response

Appellant has set forth its arguments for patentability in its previously filed Appeal Brief. Herein, Appellant briefly addresses arguments raised by the Examiner.

Claim Rejections Under 35 USC § 112

Claims 1-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. On page 4, the Examiner's Answer objects to Applicant's limitation "only if" as not being supported by the specification. Page 4 of the Examiner's Answer concedes that Applicant's specification states "if the user event does not occur within a specified time period, the attract loop code automatically transmits a request for attract loop content to the central computer." However, the Answer then argues that "this does not state 'only if' a user event does not occur is a request automatically transmitted."

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116. The fundamental factual inquiry is whether the specification conveys with reasonable clarity

to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117. Respectfully, the interpretation of the language in the Applicant's specification is so narrowly manufactured as to lead to absurd results, and one skilled in the art would appreciate the disclosure of the limitation "only if."

It is noted that page 5 of the Examiner's Answer states that "Basically, Gerszberg describes...a screen saver, including the details of the programming logic that both monitors for activity and displays content only if such activity is not provided." (emphasis added). However, a keyword search of Gerszberg's specification demonstrated that there is no mention of the phrase "only if." In fact, the word "only" appears just twice in Gerszberg's specification, first referring to "only analog voice signals" and second referring to "only small amounts of data." There is no mention of the screen saver activating only if activity is not provided. Instead, this particular language was likely imparted by the Examiner, and rightly so, because Gerszberg relates to a screensaver, which by definition looks for inactivity.

Similarly, Applicant's teachings relate to "automatically displaying web content after detection of an idle period of predetermined duration, or in other words, a screen saver which displays web-based content." (Applicant, ¶ 0002). Applicant should be afforded the same reasonable interpretation over specification language. Therefore, Applicant's use of the phrase "only if" should not be considered new matter as one skilled in the art would appreciate and recognize the limitations in Applicant's disclosure, just as the Examiner did in Gerszberg.

Claim Rejections Under 35 USC § 103

All independent claims 1, 11, 21-23, 33, 43, and 44 stand rejected under 35 U.S.C. 103(a), with the Examiner's Answer stating that "all of the independent claims

have substantially the same limitations." (Examiner's Answer, p. 4). The Examiner's Answer further states that Gerszberg et al. fails to teach the transmission of a webpage. (Examiner's Answer, pp. 5, 10). It then suggests that Gerszberg et al. could be combined with either of two secondary references, Cho et al. (U.S. Pat. No. 6,834,048) or Glaskin (article entitled "Tiny pager gives big picture; Innovation"), and that it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify Gerszberg et al. to include transmission of a web page.

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

"[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). Furthermore, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

Nowhere in the Examiner's Answer is there a discussion of the motivation to combine the references to achieve the desired result. To the contrary, Gerszberg et al. operates in a completely different way from Applicant's teachings. Gerszberg et al. is directed a screen saver for a video phone. (Gerszberg et al., Abst., "If there is no activity at a video telephone with an associated display, a video advertisement is sent to the video telephone."). Gerszberg et al.'s video phone relies on highly specialized software to control a variety of functions provided through its touch screen interface. (See, Gerszberg et al., FIG. 3A). In fact, this is the very type of system referred to in Applicant's Background section, since "using traditional screen savers, it was not possible for a third party to display a screen saver at all on a user's computer without the user specifically downloading and installing the application in the first place." Gerszberg et al.'s screen saver functionality seems to be built into the video phone's operating system and there is simply no discussion about allowing a user to download or install the screen saver software.

Applicant's teachings, meanwhile, are directed to the novel use of web-based content as a screen saver. As such, all that is required is a web browser to display content "which can be downloaded without user intervention, which does not require user installation on a user computer, and which includes media which can be modified by a third party without user intervention." (Applicant, ¶ 0028). Gerszberg et al. and the Applicant's systems work in fundamentally different ways. Even if it were possible to combine them as suggested by the Examiner's Answer, it would render Gerszberg et al.'s specialized screen saver software redundant. The two teachings are directed to solving different problems and there is just no suggestion in Gerszberg et al. about using web-content as a screen saver.

Dependent claims 2-10, 12-20, 24-32, and 34-42 are allowable at least by their dependence on independent claims 1, 11, 21-23, 33, 43, and 44.

For the foregoing reasons, as well as those set forth in Appellant's previously filed Appeal Brief, it is respectfully submitted that the claimed invention is patentable over the cited art. Accordingly, it is submitted that the rejections of the claims should be reversed.

Respectfully submitted,

January 27, 2010

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